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EXAMINER				
RASHID, DAVID				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/806,454

Applicant(s)

TABATA ET AL.

Examiner

DAVID P. RASHID

Art Unit

2624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

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Amendments & Claim Status

[1] This office action is responsive to Amendment and Reply Under 37 C.F.R. § 1.111, Feb. 6, 2009 (hereinafter "Amendment"). Claims 1-7 and 24-25 remain pending; claims 8-23 and 26-32 withdrawn.

Specification

[2] In response to Amendments to the Specification (Amendment at 2), the previous specification objections are withdrawn.

Response to Arguments

Remarks Persuasive regarding Rejections Under 35 U.S.C. § 102

Skodras does not disclose this subject matter. Skodras merely discusses a compression engine wherein subbands of coefficients are quantized and collected into rectangular arrays of "code block". (Page39, col. 1, lines 22-23.) Skodras makes no mention of using fixed length and variable length code blocks, much less mention each block of a first compression containing code length adjustment data or mention each block of a second the compressed data including marker code when the code length of the block is variable. Thus, Skodras does not disclose the limitations of the instant claim.

Applicant's Remarks at 14.

Remarks (Amendment at 13-16) with respect to the § 102 rejections of claim 1 have been respectfully and fully considered, and found persuasive. The § 102 rejection of *Skodras* has been removed.

Remarks Persuasive regarding Rejections Under 35 U.S.C. § 103

The cited art does not teach or suggest this subject matter. Hayashi merely discusses determining whether to transmit image data in a multilayer or single layer format based on whether or not the input image is in color. (Abstract and Col. 6, lines 7-36.) Hayashi makes no mention of providing image code formats for rotation and printing of an image distinct from the image code formats for the storage of the image. Nor are the deficiencies of Hayashi cured by Shishizuka.

...

Applicant's Remarks at 15-16.

Remarks with respect to the § 103 rejections of claim 1-7 have been respectfully and fully considered, and found persuasive. The § 103 rejection of *Skodras* has been removed.

Remarks Unpersuasive regarding Rejections Under 35 U.S.C. § 103

Claims 24 and 25 provide limitations similar to the limitations already discussed and for similar reason also define over the cited art.

Applicant's Remarks at 16.

Remarks with respect to the § 103 rejections of claims 24-25 have been respectfully and fully considered, but not found persuasive. Claims 24-25 do not provide limitations similar to the limitations already discussed and for similar reasons also define over the cited art. See § 103 rejections below.

Claim Rejections - 35 U.S.C. § 112

[3] In response to the Amendments to the Claims (Amendment at 3-12), the previous § 112 rejections are withdrawn.

[4] The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Failure to Particularly Point Out and Distinctly Claim

Claims 1-7 and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 and 24-25 recite "module" but it is unclear from the original disclosure what a module is (the original disclosure does not contain the word "module" for the Examiner to make such a determination).

Claim Rejections - 35 U.S.C. § 101

[5] 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

[6] The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Section IV.C, reads as follows (see also MPEP 2106):

While abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole to determine whether it is for a particular application of an abstract idea, natural phenomenon, or law of nature, rather than for the abstract idea, natural phenomenon, or law of nature itself.

For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. Diehr, 450 U.S. at 187, 209 USPQ at 8 ("application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."); Benson, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it "has no substantial practical application").

To satisfy section 101 requirements, the claim must be for a practical application of the Sec. 101 judicial exception, which can be identified in various ways:

The claimed invention "transforms" an article or physical object to a different state or thing.

The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

Judicial Exception

[7] **Claims 1-7 and 24-25** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 1-7 and 24-25 recite the mere manipulation of data or an abstract idea, or merely solves a mathematical problem without a

limitation to a practical application. A practical application exists if the result of the claimed invention is “useful, concrete and tangible” (with the emphasis on “result”)(Guidelines, section IV.C.2.b). A “useful” result is one that satisfies the utility requirement of section 101, a “concrete” result is one that is “repeatable” or “predictable”, and a “tangible” result is one that is “real”, or has “real-world” value, as opposed to being “abstract” (Guidelines, section IV.C.2.b)). Claims 1-7 and 24-25 merely manipulates data without ever producing a useful, concrete and tangible result.

For example, the “modules” performing the functional language of claim 1 are directed to manipulation of data. Images themselves comprise nothing more than a block/matrix of numeral values (pure information data). The claims in question extend no further than the manipulation of such data (e.g., compression/decompression manipulates image data, conversion of the first image data into the second is a manipulation of data, adding a marker code is manipulating data, etc.). Claims 24-25 are rejected by analogy. Claims 2-7 are rejected for failing to alleviate the rejection of their respective dependents.

It is the result that is the focus. If the result has a real world practical application/use, then the test has been satisfied. The claim need not include the uses to which the result is ultimately put, just the result itself. It is requested that a written explanation be provided as to how and why the claimed invention (either as currently recited or as amended) produces a useful, concrete and tangible result.

Claim Rejections - 35 U.S.C. § 103

[8] The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Hayashi et al. in view of Shishizuka

[9] **Claims 24-25** are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,426,809 (issued Jul. 30, 2002, hereinafter “Hayashi et al.”) in view of U.S. Patent No. 5,786,906 (issued Jul. 28, 1998, hereinafter “Shishizuka”).

Regarding **claim 24**, while *Hayashi et al.* discloses an apparatus (the computer carrying out fig. 1) for image processing comprising:

- a compressing module (fig. 1, item 12) which compresses each block of an image (image input into fig. 1, item 1) into first compressed data (the compressed data of fig. 1, item 12) with a variable code length; and

- a first code converting module (fig. 1, item 13) which converts the first compressed data (the compressed data of fig. 1, item 12) into second compressed data (the compressed data of fig. 1, item 13) with a fixed code length, *Hayashi et al.* does not disclose a decoding module which decodes the second compressed data.

Shishizuka teaches a decoding module (fig. 1, item 6) which decodes encoded data (5:15-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the apparatus of *Hayashi et al.* to include decoding module which decodes encoded data as taught by *Shishizuka*; and for the second or third compressed data of *Hayashi et al.* to be the decoded data of *Shishizuka* “to provide a method of processing an image, capable of accurately judging an input image as a color or monochrome image” (*Shishizuka* at 1:50-52) and “to provide an image processing apparatus having various editing functions.” (*Shishizuka* at 2:65-67).

Regarding **claim 25**, while *Hayashi et al.* discloses an apparatus (the computer carrying out fig. 1) for image processing comprising:

- a compressing module (fig. 1, items 12, 13) which compresses an image into first compressed data (the compressed data of fig. 1, item 12) with a fixed code length and second compressed data (the compressed data of fig. 1, item 13) with a variable code length; and

- a first code converting module ((i) fig. 1, item 15; or (ii) fig. 1, item 6 if item 4 determines the image is color because it will pull the whole image from item 72; 6:27-30) which converts the second compressed data (the compressed data of fig. 1, item 13) into third compressed data ((i) the compressed data of fig. 1, item 14; or (ii) the compressed data of fig. 1,

item 6) with a fixed code length, *Hayashi et al.* does not disclose a decoding module which decodes the first or third compressed data.

Shishizuka teaches a decoding module (fig. 1, item 6) which decodes encoded data (5:15-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the apparatus of *Hayashi et al.* to include decoding module which decodes encoded data as taught by *Shishizuka*; and for the first or third compressed data of *Hayashi et al.* to be the decoded data of *Shishizuka* “to provide a method of processing an image, capable of accurately judging an input image as a color or monochrome image” (*Shishizuka* at 1:50-52) and “to provide an image processing apparatus having various editing functions.” (*Shishizuka* at 2:65-67).

Conclusion

[10] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[11] Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID P. RASHID whose telephone number is (571)270-1578 and fax number (571)270-2578. The examiner can normally be reached Monday - Friday 7:30 - 17:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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